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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,532	10/26/2001	Chia-Pin Chiu	42390P5593C	3453

7590 02/28/2005

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EXAMINER

FLANIGAN, ALLEN J

ART UNIT	PAPER NUMBER
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3753

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/007,532	CHIU, CHIA-PIN	
	Examiner	Art Unit	
	Allen J. Flanigan	3753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 54-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 54-56, 58, 59, 61-65, 67, and 69-73 is/are rejected.
- 7) ☒ Claim(s) 57, 60, 66 and 68 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claims 54-56, 59, 61-65, 67, 69, and 70 are rejected under the judicially created doctrine of double patenting over claims 1-3, 5, and 6 of U.S. Patent No. 6,315,038. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are broader than the patent claims (they do not limit . . . “the thermal interface” to a solid layer, and they do not require the cooling device or device to be cooled to be “attached” to the thermal interface layer, but otherwise recite essentially the same limitations). The current claims can thus be said to “dominate” the patent claims. When the claims of the patent expire, any member of the public attempting to make the claimed invention would be infringing the claims of the instant application. This represents an unlawful extension of patent monopoly.

Regarding claims 55 and 63, claim 3 of the patent recites a specific material (T443 film) that is encompassed by the generic recitation of claims 55 and 63 of this application.

Regarding claim 56, this recitation is considered to be simply an alternate way of reciting “periphery” as in claim 6 of the patent or claim 59 of the instant application.

Claims 71-73 are rejected under 35 U.S.C. 102(e) as being anticipated by Baska et al.

Cap 22 of Baska et al. reads on the “thermal interface” of claim 71. Note adhesive means 28, cooling device 26 and microelectronic device 12.

Regarding claim 73, the recitations of this claim fail to distinguish the claimed device structurally over Baska et al; there is no structural distinction produced by the particular order in which the components are assembled. See MPEP 2113.

Claims 54-56, 58, 59, 61-63, 67, and 69 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamagata.

Claims listed above are anticipated by Yamagata since element 6 of Yamagata reads on the "thermal interface" of claim 54. Note adhesive 2 provided on the periphery of plate 6. Note in regard to claim 63 that the combination of plate 6 and high conductivity adhesive material 1 of Yamagata is considered readable on the claimed "phase change thermal interface", since nothing in the claim limits the "second surface" to being part of the "phase change material". The use of the term "comprising" clearly permits the presence of additional structure as part of the "thermal interface" aside from the recited "phase change material".

Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagata in view of Todman et al.

Please see the comments made in regard to the rejection of claim 2 over these references in the previous Office action.

Claims 57, 60, 66, and 68 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen J. Flanigan whose telephone number is (571) 272-4910. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Mancene can be reached on (571) 272-4930. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Allen J. Flanigan
Primary Examiner
Art Unit 3753

AJF